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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,409	11/19/2003	Nobuyuki Hiratsuka	1448.1048	5314

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EXAMINER

HWANG, JOON H

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,409

Applicant(s)

HIRATSUKA ET AL.

Examiner

Joon H. Hwang

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-10, 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 11-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The claims 1-19 re pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A computer program" in 1st line of claims 12-15 is insufficient to render the claims tangibly embodied in a manner so as to be executable. See MPEP 2106 (IV)(B)(1)(a) and 2106 (IV)(B)(2)(a).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Polnerow et al. (U.S. Patent No. 5,813,006).

With respect to claim 1, Polnerow teaches inputting a first extraction condition and extracting a first data group from data registered in a database based on the first extraction condition (i.e., a first profile-based search, lines 34-60 in col. 5). Polnerow teaches inputting a second extraction condition and extracting a second data group from the database based on the second extraction condition (i.e., a second profile-based search, lines 34-60 in col. 5). Polnerow teaches extracting common data that is data that belongs to both the first data group and the second data group and displaying information about the common data and other data, which is data in the second data group other than the common data, in a distinguishable manner (i.e., previous search result in a current search result are highlighted, lines 34-60 in col. 5).

The limitations of claims 12 and 16 are rejected in the analysis of claim 1 above, and these claims are rejected on that basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2, 11, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polnerow et al. (U.S. Patent No. 5,813,006) in view of Seto et al. (U.S. Patent No. 6,658,351).

With respect to claim 2, Polnerow discloses the claimed subject matter as discussed above except deciding a fee based on contents of the common data. However, Seto teaches deciding a fee to be charged for distribution of data based on contents of the common data (abstract, fig. 5, and lines 21-52 in col. 8) in order to provide an appropriate charge on previously charged data. Therefore, based on Polnerow in view of Seto, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Seto to the system of Polnerow in order to provide an appropriate charge on previously charged data.

With respect to claim 11, Polnerow teaches inputting a first extraction condition and extracting a first data group from data registered in a database based on the first extraction condition (i.e., a first profile-based search, lines 34-60 in col. 5). Polnerow teaches inputting a second extraction condition and extracting a second data group from the database based on the second extraction condition (i.e., a second profile-based search, lines 34-60 in col. 5). Polnerow teaches extracting common data that is data that belongs to both the first data group and the second data group and displaying information about the common data and other data, which is data in the second data group other than the common data, in a distinguishable manner (i.e., previous search result in a current search result are highlighted, lines 34-60 in col. 5). Polnerow does not explicitly disclose deciding a fee based on contents of the common data. However, Seto teaches deciding a fee to be charged for distribution of data based on contents of the common data (abstract, fig. 5, and lines 21-52 in col. 8) in order to provide appropriate charge on previously charged data. Therefore, based on Polnerow in view

of Seto, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Seto to the system of Polnerow in order to provide an appropriate charge on previously charged data.

The limitations of claims 15 and 19 are rejected in the analysis of claim 11 above, and these claims are rejected on that basis.

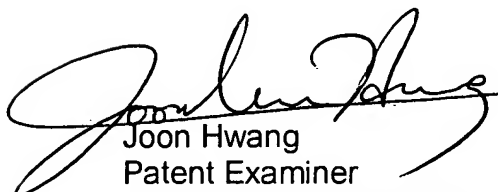
Allowable Subject Matter

8. Claims 3-10 and 17-18 are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joon Hwang
Patent Examiner
Technology Center 2100

9/29/06